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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,810	03/24/2004	Michael Albanese	10555-6	4378

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EXAMINER

DESAI, ANISH P

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/807,810	Applicant(s) ALBANESE ET AL.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 24-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a thin film sheet, classified in class 428, subclass 343.
- II. Claims 17-23, drawn to an electrical tape, classified in class 206, subclass 411.1.
- III. Claims 24-32, drawn to a method of splicing an electrical cable, classified in class 156, subclass various.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product (thin film sheet) is deemed to be useful, as a decorative wrapping and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process of using that product such as for fixing a decorative object on the wall.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the insulating tape of claim 24 does not necessarily require to have the structure of the thin film as recited by claim 1.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. William Squire on 11/28/05 a provisional election was made with traverse to prosecute the invention of Group II, claims 17-23, drawn to an electrical tape. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 and 24-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Figluzzi (US 3,537,587).

Figluzzi teaches a pressure sensitive adhesive tape such as an insulating tape (Column 1, lines 7-10). Figure 3 of Figluzzi shows a spiral role of a tape. Figures 1, 2 and 4 along with the claim 4 disclose a printed pattern on the tape. As shown in Figure 1, it seems that the pattern of Figluzzi has a different color than the sheet of the tape onto which the pattern is formed. Alternatively, the color of the pattern would have to be of a different color than the color of the sheet onto which the pattern is formed in order for the pattern to be clearly visible on the tape. Accordingly Figluzzi anticipates the claimed subject matter.

7. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Thomason (US 4,195,787).

Thomason teaches rolled products (Column 1, lines 25-26) such as tissue paper, friction tape, electrical tape etc. (Column 1, lines 7-10). Note that the tape inherently has an adhesive coating. In Figures 1-7, especially Figures 1-4, Thomason shows decorative lines (also called by marking or pattern by Thomason) (Column 1, line 19). As shown in Figures 1-4 and Figure 6, it seems that the decorative line of Thomason

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has a different color than the color of the sheet onto which these lines are formed.

Alternatively, note that the color of the markings would necessarily have to be of a different color than the color of the sheet onto which the markings are formed in order for the markings to be clearly visible on the tape. Accordingly, Thomason anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-21 are rejected under 35 U.S.C. 103(a) as obvious over Figluzzi (US 3,537,587) in view of Hughey et al. (US 6,596,945).

Figluzzi teaches a pressure sensitive adhesive tape such as an insulating tape (Column 1, lines 7-10). The invention of Figluzzi relates to a new and improved means for marking a tape such that the location of the free end of the tape can be ascertained in order to remove the tape from a roll (Column 1, lines 1-6). Regarding claim 17, Figure 3 of Figluzzi shows a spiral roll of a tape with overlying multiple layers and a free end 13 of the tape, which reads on the layers having a free end terminating at an edge on the outermost layer of the roll and the edge overlying the outer surface of the next adjacent radially inward layer. Figures 1, 2 and 4 show a printed pattern/marking and especially Figure 4 shows repetitive pattern (Column 2, lines 7-8). Although

Figluzzi does not explicitly teach the color of the repetitive pattern being different than the color of the sheet, the examiner takes the position that the color of the pattern would be substantially necessarily be different than the color of the backing (sheet) so that the free end of the tape can be easily identified.

Figluzzi does not specifically teach an opaque sheet. However, Hughey et al. teach a novel process or method which produces polymeric tapes such as an insulating tape (Column 7, lines 22-23 and Column 9, line 8). At column 8, lines 51-65, Hughey et al. teach of adding color dyes in specific quantities to a transparent backing of the tape so that the operator can easily distinguish the edges of the immediate previous layers of the tape from those of the earlier layer. Thus, a skilled artisan would have found it obvious to use an opaque (colored) sheet in the invention of Figluzzi, motivated by the desire to easily identify the free end of the tape from the immediate previous layer of the said tape.

With respect to claims 18 and 19, Figure 2 and Figure 4 of Figluzzi, show a pattern that has discontinuous portions and a pattern that is continuous respectively.

With respect to claim 20, Figure 2 and claim 4 of Figluzzi read on the claimed limitation of the pattern at the edge is discontinuous with the pattern on the juxtaposed surface of the next adjacent radially inward layer.

Regarding claim 21, Figures 1, 2, and 4 of Figluzzi show pattern of lines, curved lines, and sinusoidal curves.

9. Claims 17-21 are rejected under 35 U.S.C. 103(a) as obvious over Thomason (US 4,195,787) in view of Hughey et al. (US 6,596,945).

Thomason teaches rolled products (Column 1, lines 25-26) such as tissue paper, friction tape, electrical tape etc. (Column 1, lines 7-10). The invention of Thomason provides marking arrangements, which permits easy access to the beginning or the front part of the rolled product (Column 1, lines 11-13). Note that the tape of Thomason necessarily has an adhesive coating. Regarding claim 17, Figures 1-4, and Figure 6 show marking arrangements on a rolled product. Note that the rolled product shown in Figure 6 necessarily has overlying multiple layers and meets the claim limitation of the layers having a free edge terminating at an edge on the outermost layer of the roll, the edge overlying the outer surface of the next adjacent radially inward layer. In Figures 1-7, especially Figures 1-4 and at Column 2, lines 26-29, Thomason teaches that the decorative lines (markings) are repeated along the length of the roll. Although, Thomason does not explicitly teach the color of the repetitive pattern different than the color of the sheet, the examiner takes the position that the color of the markings would be substantially necessarily be different than the color of the backing (sheet) so that the free end of the tape can be easily identified.

Thomason does not specifically teach an opaque sheet. However, Hughey et al. teach a novel process or method which produces polymeric tapes such as an insulating tape (Column 7, lines 22-23 and Column 9, line 8). At column 8, lines 51-65, Hughey et al. teach of adding a color dyes in specific quantities to a transparent backing of the tape so that the operator can easily distinguish the edges of the immediate previous

layers of the tape from those of the earlier layer. Thus, a skilled artisan would have found it obvious to use an opaque (colored) sheet, motivated by the desire to easily identify the free end of the tape from the immediate previous layer of the said tape

With respect to claims 18 and 19, Figures 1-4 of Thomason show markings that are continuous and markings with repetitive discontinuous portions.

With respect to claim 20, Figure 6 of Thomason shows marking at an edge that is discontinuous with the marking on the juxtaposed surface of the next adjacent radially inward layer.

With respect to claim 21, Figures 1-4 of Thomason show markings that are in the forms of sinusoidal curves/curved lines, straight lines, and lines angled relative to each other

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Figluzzi (US 3,537,587).

The invention of Figluzzi as applied to the base claim 21 is previously disclosed. Figluzzi is silent with respect to teaching the second color is one of green, white and red. Note that Figluzzi and applicants are concerned with the same problem, namely to provide a roll of a tape with a pattern such that the free end of the tape is easily visible to a user. Therefore, it is the examiner's position that the choice of a color involves routine skill in the art and thus is not a patentable over the prior art. Therefore, a skilled artisan would have found it obvious to select the color of the patter of Figluzzi from any of green, white and red, motivated by the desire to provide a tape with a pattern such that the free end of the tape is clearly visible.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomason (US 4,195,787).

The invention of Thomason as applied to the base claim 21 is previously disclosed. Thomason is silent with respect to teaching the second color is one of green, white and red. Note that Thomason and applicants are concerned with the same problem, namely to provide a roll of a tape with a pattern such that the free end of the tape is easily visible to a user. Therefore, it is the examiner's position that the choice of a color involves routine skill in the art and thus is not a patentable over the prior art. Therefore, a skilled artisan would have found it obvious to select the decorative line (markings) of Thomason from any of green, white and red, motivated by the desire to provide a tape with a decorative line such that the free end of the tape is clearly visible.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

Hai Vo

**HAI VO
PRIMARY EXAMINER**